

REMARKS

Claims 1-15 remain in the application. The potential allowability of claims 5-14 is noted with appreciation.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin et al. ("Martin") in view of WO 97/09596 ("WO"), both of record. This rejection is respectfully traversed.

Martin is contrasted on page 3 of the subject application. Martin discloses a temperature sensor in the form of a bolt. The sensor is not meant to supply information on the level of temperature but is only designed to send an alarm signal if a threshold is exceeded. The element in Martin is thus not able to perform the same function as the invention because Martin is not adapted to measure temperature. Martin does not measure variations in temperature but rather responds only to a temperature threshold and, as such, is either on or off.

The WO document does not correct the shortcomings of Martin. The structure and operation of the WO device was discussed in the Request for Reconsideration filed December 4, 2003. While it is acknowledge that the SAW sensor of WO will measure temperature, there is no description of how such a sensor is capable of being installed so as to be sufficiently robust when used in a particularly harsh environment such as in an engine, especially where the measurements must be taken deep within the engine.

In addition, it should be noted that the expansion function in the Martin patent is indispensable to the intended operation in which the cap 22 is removed, allowing extension of the antenna 56 which then transmits as an indication of excess temperature. Substitution of the SAW sensor of WO into the Martin device could not bring about this result. For that reason, the replacement of the temperature sensor in

Martin with the SAW temperature sensor of WO would destroy the operation of the Martin disclosure. Thus, the two sensors of Martin and WO are not merely “alternate types of temperature sensors” which, as the Examiner incorrectly maintains, will perform the same function, and it would not be obvious to a skilled artisan to make the substitution relied on by the Examiner under 35 U.S.C. § 103(a). The rejection of claims 1-3 should be withdrawn.

The Examiner attempts to negate the effect of the preamble and the functional language of claim 1 by relying on selected case law. It is submitted that such reliance is misplaced. Claim 1 in its preamble, body, and closing functional language are directed, unlike Martin, to the measurement of temperature. “[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Communications Research Inc. v. Vitalink Communications, 55 F3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

Claim 1 recites in the preamble of the claim that the device is for measuring temperature on the inside of an inaccessible movable mechanical part and adds in the body of the claim that it is the temperature-sensitive element from which a measurement of temperature can be obtained. The “whereby” clause adds the capability of temperature measurement in the inaccessible part is in motion. These recitations not only assist in defining the invention of claim 1 and its dependent claims but also effectively rule out Martin as a reliable primary reference on which to reject any claim in the application. The inventor invented and intended to encompass by claim 1 an effective device that could measure temperature in the environment of a

movable mechanical part that was inaccessible while in motion. As noted above, Martin does not and cannot measure temperature in this environment.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Martin and WO, further in view of Waters et al. ("Waters"), of record. Waters shows the use of an epoxy to retain in place the bolt 50 of a temperature sensor. However, Waters fails to correct the deficiencies of Martin and WO set forth above.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Martin, WO, and Schurmann, of record. This rejection is also respectfully traversed. Claim 15 as does claim 1 distinguishes over Martin and WO because it recites in the preamble the system for monitoring the temperature inside an inaccessible moving mechanical part, and recites in the body of the claim the encapsulation to measure temperature inside the mechanical part. See also the problem of attempting to combine Martin and WO as set forth hereinabove.

Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Examiner is requested to review and initial the Supplemental Information Disclosure Statement and Form PTO 1449 filed on February 17, 2004.

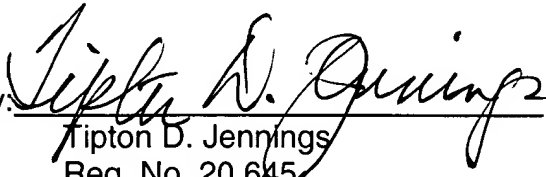
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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